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MAY 20 2008 Attorney's Docket: 2003DE117
Serial No.: 10/533,475
Group: 1713

REMARKS

The Office Action mailed January 4, 2008, has been carefully considered together with the reference cited therein. The remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

CLAIM STATUS

Claims 1-5, 7 and 9-13 are pending in this Application.

Claim Rejections Under 35 USC § 102 and § 103

Claims 1-5, 7 and 9-13 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Hohner (US 5,998,547). These rejections are respectfully traversed.

Beginning with § 102, it is axiomatic that a § 102 rejection requires the prior art to disclose each and every element of an applicant's invention.

It continues to be Applicants' respectful position that Hohner does not teach, disclose or suggest a composition having at least one polyolefin wax that is not polar modified. In contrast, it is respectfully contended that Hohner discloses that its composition must have wax that is polar modified.

The Hohner reference is replete with instances describing polypropylene wax as being polar. Non-exhaustive instances of this fact are as follows:

1. Title: Polypropylene Waxes Modified So As To Be Polar
2. Abstract: "The present invention relates to partially crystalline polypropylene homopolymer or copolymer waxes modified so as to be polar . . ."
3. Column 1, lines 4-7: "The invention relates to polypropylene waxes modified so as to be polar . . ."

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4. Column 1, lines 56-59: "It is thus an object of the invention to provide a polar polypropylene wax which can be prepared simply, economically and reproducibly while avoiding the abovementioned disadvantages."
5. Column 1, lines 60-67: "It has been found that polypropylene waxes which have been prepared in an economical manner in a direct polymerization by means of catalysts of Ziegler or metallocene type can be reacted with suitable monomers . . . without danger of viscosity increase and without a risk of thermal damage to polar waxes".
6. Column 2, lines 1-4: "The invention accordingly provides a partially crystalline polypropylene homopolymer or copolymer wax modified so as to be polar . . ."
7. Column 3, lines 27 and 28: "The polar waxes of the present invention have an acid or saponification number of from 0.5 to 120 mg KOH/g . . ."
8. Column 3, lines 35 and 36 "Such polypropylene waxes modified so as to be polar have many possible applications."

These examples, among others, are unequivocal evidence that Hohner is directed exclusively to a composition wherein that the wax must be polar modified. This is in direct contrast to that which is claimed, namely that the polyethylene is not polar modified.

With respect to the § 102 rejection, it is beyond contention that the prior art reference must disclose each and every aspect of the claimed invention. Here, not only does Hohner undeniably make clear that the wax is polar modified but in essence teaches away from the instant invention.

For at least this reason it is respectfully contended that the 35 USC § 102 rejection has been traversed.

On page 5 of the Office Action, the Office, in supporting its rejection, discloses column 2, lines 28-51 of Hohner for the proposition that the polypropylene waxes are not polar modified. However, courteously stated, the Office has misconstrued this section of the reference. In column 2, lines 15-column 3, line 10,

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Hohner is speaking to a method of preparation of the wax. Specifically, Hohner is stating that these waxes are "starting materials." Please see Column 2, lines 15 and 16, line 29 and 43. These are the starting waxes for which Hohner explains the process by which polar modification is to occur. Such further modification is laid out in column 3, lines 10-46 which is reproduced hereinbelow:

The reaction of the polypropylene wax with the polar component can be carried out either continuously or batchwise. In the batchwise procedure, the wax is heated to a temperature above its softening point and both the polar component and the peroxide are introduced into the melt while stirring, either continuously over an appropriate period of time or in one or more portions, if desired under a blanket of inert gas. The reaction temperature is above the softening point of the wax, preferably from 100 to 200°C., particularly preferably from 130-180°C. After metering-in is complete, the mixture can be left to react further at the same temperature or a different temperature, if desired after addition of a further amount of peroxide. Volatile components formed during the reaction or excess volatile starting components can, for example, be distilled off under reduced pressure or be removed by stripping with inert gas.

The polar waxes of the present invention have an acid or saponification number of from 0.5 to 120 mg KOH/g, a melt viscosity of 20-50,000 mPa.s and a softening point (ring/ball) of 90-165°C., preferably 90-145°C. They are pale in color and homogeneous, their melt viscosity is lower than that of the wax raw material used, at most approximately similar, and they are free of high molecular weight or crosslinked material. Such polypropylene waxes modified so as to be polar have many possible applications. They may be used in melt adhesive formulations, as dispersants for inorganic and organic colorants in pigment masterbatch preparations for coloring plastics, as release agents in phototoner mixtures or as additives in plastics processing. If the polarity is sufficiently high, the waxes can be processed in the presence of customary auxiliaries to give finely divided, stable aqueous dispersions. Such dispersions are suitable as formulation components in, for example, floor, automobile, furniture and shoe care products and also for use in industrial emulsions, for instance for textile processing.

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Thus, the text that the Office was referring to, in an attempt to justify its rejection, speaks only to the starting materials that have not undergone polar modification. It is clear to one with ordinary skill in the art that those materials referenced by the Office are only starting materials that undergo further processing to become polarized in accordance with the invention of Hohner. This position is buttressed by the language of column 3, lines 15 and 16 stating: "The synthesis of the unmodified, i.e. non-polar, starting waxes . . ."

On Page 6 of the Office Action, the Office further attempts to show that Hohner discloses a non polarized wax by reference to the claims.

The Office begins its claims analysis by stating the following:

Hohner (col. 8, claims 13-16) clearly claims using the disclosed composition as adhesives. In view of substantially identical material compositions, and dropping point or ring & ball softening point of between 80 and 165°C properties, the examiner has a reasonable basis to believe that the claimed "measured at a temperature 10°C above the dropping or softening point" and the molecular weight properties are inherently possessed in Hohner. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise, *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

The Offices argument, with all due respect, is inapposite. Claim 13 depends from claim 9. If the Office will kindly refer to claim 9, the preamble states the following: "A process for producing a partially crystalline polypropylene homopolymer or copolymer wax modified so as to be polar. . ."

Claim 14 depends from claim 10. An examination of claim 10 reveals the following preamble: "A process for producing a partially crystalline polypropylene homopolymer wax modified so as to be polar. . ."

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Claim 15 depends from claim 11. An examination of claim 11, in the preamble, reads as follows: "A process for producing a partially crystalline polypropylene homopolymer or copolymer wax modified so as to be polar . . ."

Claim 16 depends from claim 12 which reads in the preamble: "A process for producing a partially crystalline polypropylene homopolymer wax modified so as to be polar . . ."

Each one of these claims refer directly to an independent claim that claims a method for producing a wax that is polar modified.

Turning to obviousness under § 103, it is respectfully stated that the Office has not carried its burden of providing a *prima facie* case of obviousness.

The Hohner reference is undeniably directed to polar modified waxes. As demonstrated above, there is no instance, or suggestion, teaching or motivation for a wax which is not polar modified.

Respectfully stated, one with ordinary skill in the art regarding Hohner would have no motivation to replace its polar modified wax with the non polar wax of Applicants' claimed invention. Specifically, Hohner teaches directly away from Applicants' invention as Hohner's reference is entirely dedicated to polar modified waxes, whereas Applicants specifically claim a wax which is not polar modified. This is in consonant with MPEP § 2145 X.(D.). As Hohner teaches away from the claimed invention, one of ordinary skill would have an express disincentive to modify Hohner in the manner proffered by the Office. Applicants' position is solidified by case law repeatedly stating that teaching away from a claimed invention is strong evidence of non-obviousness. See for example *In re Hedges*, 783 F.2d 1038, 1041; 228 USPQ 685, 687(Fed. Cir. 1986); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 USPQ 303, 312 (Fed. Cir. 1983).

In order for an ordinary artisan to arrive at Applicants' claimed invention one must first abandon the express teachings of Hohner in order to do so. It is undeniably the state of the law that one with ordinary skill in the art having an

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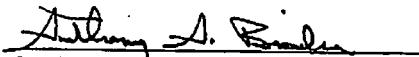
express disincentive to abandon the teachings of the prior art in order to arrive at the claimed invention is also strong indicia of non-obviousness.

Finally, in providing a *prima facie* case of obviousness under § 103, the Office must consider each and every limitation of the claimed invention. Here, as described above, Hohner does not teach, disclose, suggest or intimate the use of a polyolefin wax which is not polar modified.

For at least the foregoing reasons it is respectfully contended that the 35 USC § 103 rejection has been traversed. In consequence, Applicants respectfully request reconsideration and withdrawal of the rejection.

In view of the forgoing remarks, the Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicant at the telephone number provided below.

Respectfully submitted,


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